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ART UNIT	PAPER NUMBER
3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/603,306	WOLFE, BRIAN
	Examiner	Art Unit	
	Natalie A. Pass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 October 2005*.

2a)☐ This action is **FINAL**.　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-9,11-25,27-39,41-46 and 58-61* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-9,11-25,27-39,41-46 and 58-61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date *8 July 2005*.

4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Notice to Applicant

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 13 October 2005 has been entered. The

Information Disclosure Statement filed 8 July 2005 has been entered and considered

2.   This communication is in response to the Request for Continued Examination and the

amendments filed 13 October 2005. Claims 1, 17, and 31 have been amended. Claims 5, 10, 26,

40, 47-57, and 62-63 have been cancelled. Claims 1-4, 6-9, 11-25, 27-39, 41-46, 58-61 remain

pending.

Claim Objections

3.   Claim 21 is objected to because of the following informalities: in the claim listing, the

status of every claim must be indicated after its claim number by using one of the following

identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled),

(Withdrawn), (Previously presented), (New), and (Not entered). See 37 CFR 1.121 (c). The

status identifier for claim 21 reads "(currently amended)" however no changes are evident. For

the purpose of applying art, Examiner assumes the status identifier to read "(previously

presented)." Appropriate correction is required.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.   Claims 1, 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A)   Claims 1, 31 recite the limitation "the information received" in lines 30-31 and 31 respectively. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1-4, 9, 14, 16-21, 25, 30-35, 39, 44, 46, 58, 60-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711 in view of Kuwamoto et al, U.S. Patent Number 5, 483, 632, and further in view of Provost, U.S. Patent Number 6, 341, 265.

(A)   Claim 1 has been amended to recite the limitations

- "of processing a bodily injury insurance claim," in the preamble;

- "sending an insurance claim to the insurance claims processing program," in

lines 9-10;

- "automatically generates one or more processing steps in response to the

insurance claim" in lines 11-12;

- "automatically displays one or more processing steps to a user " in line 13;

- "automatically generates ... [...] ... to the user based on the displayed

processing steps" in lines 14-16;

- "automatically searches" in line 17;

- "automatically retrieves" in line 20;

- "automatically ... [...] ... and wherein the message text is displayed along

with one or more of the processing steps" in lines 24-28; and

- "automatically ... [...] ... information received regarding" in lines 29-31.

As per newly amended claim 1, Huffman teaches a method comprising:

sending an insurance claim to the insurance claims processing program (Huffman;

column 4, line 65 to column 5, line 13), wherein the insurance claims processing program:

automatically generates one or more processing steps in response to the insurance claim

(Huffman; column 5, lines 51-66);

automatically "displays the adjuster activity report to the screen" (reads on "displays one

or more processing steps to a user" (Huffman; Figures 6, 7, 11, column 7, lines 15-24, column

11, lines 37-57, column 12, lines 50-53);

automatically generates a request to display a message to the user based on the displayed

processing steps, wherein the request comprises a requested message code (Huffman; column 7,

lines 7-20); Examiner interprets Huffman's teachings of "the system automatically... [...]

...create[s] correspondence ... [...] ... generate[s] copies of letters to carbon copy or blind copy

individuals with a unique message to each recipient... [...] ... utilizing standard form letters

contained within the system," as teaching this limitation;

automatically "queries" (reads on "searches") the database for a matching entry which

matches the requested message code, wherein the database stores a plurality of entries including

the matching entry (Huffman; column 10, lines 50-52, column 11, lines 62-66); and

wherein the message text is configured to assist a user in processing an insurance claim

using the insurance claims processing program (Huffman; Figure 6, column 2, lines 44-65,

column 3, lines 39-41, column 7, lines 16-19, column 12, lines 50-53), and wherein the program

"displays the adjuster activity report to the screen" (reads on "the message text is displayed along

with one or more of the processing steps" (Huffman; column 11, lines 37-57, column 12, lines

50-53).

Although Huffman teaches querying a database "table entitled "AMS Message Table"

contained in the AMS subsystem. This table contains the message text for each AMS message

for conversion to a DBASE IV record followed by broadcast via the SABRE interface,"

(Huffman; column 10, lines 50-52, column 11, lines 62-66), Huffman fails to explicitly disclose

a method that includes

providing a database, each entry in the database comprising a message code and a

corresponding message text;

customizing the message text of at least one of the entries for a particular insurance

company during an installation of an insurance claims processing program on a computer

system, wherein said customizing the message text comprises modifying the message text of at

least one entry during the installation;

automatically retrieves the matching entry from the database in response to said searching

the database for the matching entry which matches the requested message code, wherein the

matching entry comprises a matching message text; and

automatically displaying the matching message text corresponding to the requested

message code.

However, the above features are well-known in the art, as evidenced by Kuwamoto.

In particular, Kuwamoto teaches

providing a database, each entry in the database comprising a message code and a

corresponding message text (Kuwamoto; Figure 5, Figure 7, item 704, Figure 9B, Figure 10,

column 2, lines 32-59, column 5, lines 49-59, column 6, lines 5-8);

customizing the message text of at least one of the entries for a particular insurance

company during an installation of an insurance claims processing program on a computer

system, wherein said customizing the message text comprises modifying a help message (reads

on "modifying the message text") of at least one entry during the installation (Kuwamoto; Figure

4, Figure 14, see at least Item 1431, column 2, line 60 to column 3, line 64, column 10, lines 44-

45);

automatically retrieves the matching entry from the database in response to said searching

the database for the matching entry which matches the requested message code, wherein the

matching entry comprises a matching message text (Kuwamoto; Abstract, column 2, line 60 to

column 3, line 24, column 6, line 56 to column 7, line 16); and

automatically displaying the matching message text corresponding to the requested

message code (Kuwamoto; Abstract, column 2, line 60 to column 3, line 24, column 6, line 56 to

column 7, line 16).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the method of Huffman to include the above limitations, as taught by

Kuwamoto, with the motivations of providing a method and a system of help-information

whereby "the help program references the executing status retained by the system program in

order to look for pertinent help data and output relevant help information" (Kuwamoto; column

2, lines 34-37).

Although Huffman teaches "the system automatically calculate[s] the potential liability of

the claim" (reads on "automatically estimating a ... [...] ...value of the insurance claim by

processing the information received regarding the insurance claim," Huffman fails to explicitly

disclose a bodily injury claim.

However, the above features are well-known in the art, as evidenced by Provost.

In particular, Provost teaches

automatically estimating a bodily injury general damages value of the insurance claim by

processing the information received regarding the insurance claim, wherein the insurance claim

comprises a bodily injury claim (Provost; column 6, lines 22-26, column 9, lines 35-42).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the collective teachings of Huffman and Kuwamoto to include the above

limitations, as taught by Provost, with the motivations of providing a more fully automated

claims processing system, of reducing the uncertainty as to whether an insurance claim to be

submitted is likely to be paid or rejected, and of providing a claims processing system that would

more easily allow health care providers to know what patient and treatment information must

accompany insurance claims (Provost; column 3, lines 10-20).

      (B)   As per claims 2-4, Huffman, Kuwamoto, and Provost teach a method as analyzed

and disclosed in claim 1 above, further comprising:

     specifying the message text of each entry in the database during an installation or

initialization of the insurance claims processing program or application on a computer system

(Kuwamoto; Figure 4, Figure 5, column 3, lines 29-54, column 5, lines 30-47, column 8, lines

56-60);

     specifying the message text of each entry in the database during an installation or

initialization of the database or application on a computer system (Kuwamoto; Figure 4, Figure

5, Figure 10, column 3, lines 29-54, column 5, lines 30-47, column 8, lines 28-42, 56-60); and

     further comprising updating the message text of each entry in the database by re-

installing the database on the computer system without re-installing the insurance claims

processing program or application on the computer system (Kuwamoto; Figure 14, see at least

Item 1431, column 9, lines 45-67, column 10, lines 25-67).

     The motivations for combining the respective teachings of Huffman, Kuwamoto, and

Provost are as given in the rejection of claim 1 above, and incorporated herein.

(C)   As per claims 9, 16, 58, Huffman, Kuwamoto, and Provost teach a method as

analyzed and disclosed in claim 1 above,

wherein each message code comprises a message section and a message code identifier

(Kuwamoto; Figure 5, Item 503, Figure 7, column 2, lines 32-34, 45-59, column 5, lines 49-59,

column 6, lines 5-8);

and wherein each message code comprises a sequence of alphanumeric values (reads on

address), wherein each sequence is unique relative to the other sequences (Kuwamoto; Figure 5,

Item 503, column 11, lines 59-57);

wherein the matching message text or error message warns a user of the insurance claims

processing program of an out of range input value (Provost; column 10, lines 16-22).

The motivations for combining the respective teachings of Huffman, Kuwamoto, and

Provost are as given in the rejection of claim 1 above, and incorporated herein.

(D)   Claim 17 has been amended to recite the limitations

- "receive an insurance claim," in line 14;

- "automatically generates one or more processing steps in response to the
insurance claim" in lines 15-16;

- "automatically displays one or more processing steps on the display device "
in line 17;

- "automatically ... [...] ... to the user based on the displayed processing steps"
in lines 18-19;

- "automatically" in line 21, 23;

- "automatically ... [...] ... and wherein the message text is displayed along with one or more of the processing steps" in lines 25-29; and

- "automatically ... [...] ... information received regarding" in lines 30-31.

Claim 17 differs from method claim 1, in that it is a system rather than a method for processing an insurance claim.

System claims 17-20, 25, 30 repeat the subject matter of claims 1-4, 9, 16, respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 1-4, 9, 16 have been shown to be fully disclosed by the collective teachings of Huffman, Kuwamoto, and Provost in the above rejection of claims 1-4, 9, 16, it is readily apparent that the system disclosed collectively by Huffman, Kuwamoto, and Provost includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1-4, 9, 16, and incorporated herein.

The motivations for combining the respective teachings of Huffman, Kuwamoto, and Provost are as given in the rejection of claim 1 above, and incorporated herein.

(E)   Claim 31 has been amended to recite the limitations

- "sending an insurance claim to the insurance claim processing program," in lines 9-10;

- "automatically generates one or more processing steps in response to the insurance claim" in lines 11-12;

- "automatically displays one or more processing steps to a user" in line 13;

- "automatically generates ... [...] ... to the user based on the displayed

processing steps" in lines 14-15;

- "automatically searches" in line 17;

- "automatically retrieves" in line 21;

- "automatically displays ... [...] ... and wherein the message text is displayed

along with one or more of the processing steps" in lines 25-29; and

- "automatically estimates ... [...] ... information received regarding" in lines

30-31.

Claims 31-34, 39, 46, differ from method claims 1-4, 9, 16, respectively by

reciting a "carrier readable medium comprising program instructions..." in the preamble. As per

this limitation, Huffman clearly discloses his invention to be implemented on a "carrier readable

medium comprising program instructions" (Huffman; column 4, lines 24-35). The remainder of

claims 31-34 repeat the limitations of claims 1-4, 9, 16, and are therefore rejected for the same

reasons given above for claims 1-4, 9, 16.

The motivations for combining the respective teachings of Huffman, Kuwamoto, and

Provost are as given in the rejection of claim 1 above, and incorporated herein.

(F)   As per claims 14, 21, 35, 44, Huffman, Kuwamoto and Provost teach a method

and carrier medium as analyzed and disclosed in claims 1 and 31 above,

wherein said displaying the matching message text corresponding to the requested

message code comprises the insurance claims processing program displaying the matching

message text (Provost; column 4, lines 39-50, column 10, lines 16-22); and

further comprising customizing the message text of at least one of the entries in the

database for a particular insurance organization during an installation of the insurance claims

processing program on a computer system (Kuwamoto; Figure 4, Figure 14, see at least Item

1431, column 2, line 60 to column 3, line 64, column 10, lines 44-45).

The motivations for combining the respective teachings of Huffman, Kuwamoto, and

Provost are as given in the rejection of claim 1 above, and incorporated herein.

(G)   As per claims 60-61, Huffman, Kuwamoto and Provost teach a method as

analyzed and discussed in claim 1 above further comprising

modifying at least one processing step of the insurance claim processing program in

response to said displaying of the matching message text (Huffman; column 2, lines 44-65,

column 3, lines 39-41, column 7, lines 7-35, column 12, lines 50-53), (Kuwamoto; Figure 2,

column 2, line 60 to column 3, line 24, column 5, line 59 to column 6, line 4, column 6, line 56

to column 7, line 22, column 9, lines 7-24); and

wherein said specifying the message text of each entry in the database comprises

modifying a help message (reads on "modifying the message text") of at least one of the entries

in the database during the installation of the insurance claims processing program on the

computer system (Kuwamoto; Figure 4, Figure 10, Figure 14, see at least Item 1431, column 2,

line 60 to column 3, line 64, column 5, lines 30-47, column 8, lines 28-42, 56-60, column 9, lines

45-67, column 10, lines 25-67).

The motivations to combine the respective teachings of Huffman, Kuwamoto and Provost

are as discussed in claim 1 above, and incorporated herein.

8.   Claims 11-13, 15, 27-29, 41-43, 45, 59 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Huffman, U.S. Patent Number 5, 870, 711, Kuwamoto et al, U.S. Patent

Number 5, 483, 632 and Provost, U.S. Patent Number 6, 341, 265, as applied to claims 1, 17, and

31 above, and further in view of Ertel, U.S. Patent Number 5, 307, 262.

        (A)   As per claims 11-12, 27-28, 41-42, Huffman, Kuwamoto, Provost and Ertel teach

a method and system and carrier medium as analyzed and disclosed in claims 1, 17, and 31

above.

        Huffman, Kuwamoto, and Provost fail to explicitly disclose:

        wherein the requested message text comprises information relevant to an estimate of a

value of the insurance claim; and

        wherein the requested message code comprises an injury code which identifies a specific

bodily injury or diagnosis, and wherein the requested message text comprises a name of the

specific bodily injury or diagnosis.

        Ertel teaches

        wherein the requested message text comprises information relevant to an estimate of a

value of the insurance claim (Ertel; column 6, lines 37-39, column 10, lines 4-7, column 13, lines

5-9, column 15, lines 39-49, column 32, lines 18-21), and

        wherein the requested message code comprises an injury code which identifies a specific

bodily injury or diagnosis, and wherein the requested message text comprises a name of the

specific bodily injury or diagnosis (Ertel; column 11, lines 25-45, column 12, lines 4-19, 31-45,

column 12, line 66 to column 13, line 9, column 25, lines 57-64, column 27, lines 5-7, column

35, lines 5-12)..

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the method and system of Huffman, Kuwamoto, and Provost to include

these limitations, as taught by Ertel, with the motivations of managing the process of improving

the quality and accuracy of reportable insurance claims data, allowing the analysis of claims data

for the purpose of identifying and correcting both case-specific and systematic problems in data

quality in the most efficient way possible, making it possible to prioritize individual cases for in-

depth review based upon user-defined criteria of importance, automatically routing relevant data

quality messages to the appropriate recipient personnel, and providing a method and system to

improve the accuracy, completeness, and overall quality of claims data (Ertel; column 5, lines

20-53).

(B)   As per claims 13, 15, 29, 43, 45, 59, Huffman, Kuwamoto, Provost and Ertel

teach a method and system and carrier medium as analyzed and disclosed in claims 1, 17, and 31

above,

wherein the requested message code comprises a treatment or procedure code which

identifies a specific injury treatment or procedure, and wherein the requested message text

comprises a name of the specific injury treatment (Ertel; column 17, lines 25-49), and

wherein said displaying the matching message text corresponding to the requested

message code comprises displaying the matching message text on a display device coupled to a

computer system (Ertel; column 6, lines 9-22);

further comprising estimating a bodily injury general damages value based at least in part

on the specific injury treatment (Provost; column 3, lines 55-62).

The motivations for combining the respective teachings of Huffman, Kuwamoto, Provost and Ertel are as given in the rejections of claims 1, and 11 and above, and incorporated herein.

9.   Claims 6, 22, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711, Kuwamoto et al, U.S. Patent Number 5, 483, 632 and Provost, U.S. Patent Number 6, 341, 265, as applied to claims 1, 17, and 31 above, and further in view of Winans, U.S. Patent Number 5, 307, 265.

(A)   As per claims 6, 22, 36, Huffman, Kuwamoto, and Provost teach a method and system and carrier medium as analyzed and disclosed in claims 1, 17, and 31 above.

Huffman, Kuwamoto, and Provost fail to explicitly disclose wherein the message text of one or more entries in the database is localized for use in a particular geographical location.

Winans teaches wherein the message text of one or more entries in the database is localized for use in a particular geographical location (Winans; Figures 4A, 4B, 5A, 5B, 6B, Items 10, 11, 12, 13, column 3, lines 11-22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Huffman, Kuwamoto, and Provost to include wherein the message text of one or more entries in the database is localized for use in a particular geographical location, as taught by Winans, with the motivation of configuring each installation to be sensitive only to the language needs of users entering the network at its local site, making it appear to each user in the network that every node in the network speaks his or her language--i.e. as though the entire network were a single system, and in this way optimizing the user-friendliness of the product for both end users and installations, and minimizing the amount of

data that must be transmitted through the network to effect program-to-user communications

(Winans; Abstract, column 2, lines 18-26).

10.   Claims 7-8, 23-24, 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Huffman, U.S. Patent Number 5, 870, 711, Kuwamoto et al, U.S. Patent Number 5, 483, 632 and

Provost, U.S. Patent Number 6, 341, 265, as applied to claims 1, 17, and 31 above, and further in

view of McGauley, U.S. Patent Number 5, 899, 998.

(A)   As per claims 7-8, 23-24, 37-38, Huffman, Kuwamoto, and Provost teach a

method and system and carrier medium as analyzed and disclosed in claims 1, 17, and 31 above.

Huffman, Kuwamoto, and Provost fail to explicitly disclose wherein the database

comprises a relational database, and wherein the database comprises an object-oriented database.

McGauley teaches wherein the database comprises a relational database (McGauley;

Figure 6, Item 154, column 7, lines 7-14, 20-38) and wherein the database comprises an object-

oriented database (McGauley; Figure 6, Item 152, Abstract, column 1, lines 29-35, column 7,

lines 7-14, 20-38).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the method of Huffman, Kuwamoto, and Provost to include wherein the

database comprises a relational database, and wherein the database comprises an object-oriented

database, as taught by McGauley, with the motivation of utilizing two types of databases in

common use, both collections of data and software programs, to establish, route, organize, store

and update information of a plurality of users (McGauley; column 1, lines 29-35).

Response to Arguments

11.   Applicant's arguments filed 13 October 2005 have been fully considered but they are not

persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they

appear in the response filed 13 October 2005.

(A)   At page 13 of the 13 October 2005 Applicant apparently lists the cancelled claims

incorrectly. Examiner assumes this is a typographical error, and notes that the correct listing of

cancelled claims appears in paragraph 2 above.

(B)   At pages 13-18 of the 13 October 2005, Applicant apparently argues that a *prima*

facie case of obviousness has not been established.

In response, the Examiner respectfully submits that obviousness is determined on the

basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re*

Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges,* 783 F.2d

1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki,* 745 F.2d 1468, 1472, 223

USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart,* 531 F.2d 1048, 1052, 189 USPQ 143,147

(CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of

presenting a *prima facie* case of obviousness has at least been satisfied, since evidence of

corresponding claim elements in the prior art has been presented and since Examiner has

expressly articulated the combinations and the motivations for combinations that fairly suggest

Applicant's claimed invention. Note, for example, the motivations explicitly stated at lines 8-10

of page 7 of the present Office Action (i.e., " ... with the motivations of providing a method and

a system of help-information whereby "the help program references ... in order to look for

pertinent help data and output relevant help information"), and at lines 1-5 of page 8 of the

present Office Action (i.e., " ... with the motivations of providing a more fully automated claims

processing system ... ") and in lines 3-9 of page 14 of the present Office Action (i.e., "... with

the motivations of managing the process of improving the quality and accuracy of reportable

insurance claims data ...".

In response to Applicant's argument, the Examiner recognizes that obviousness can only

be established by combining or modifying the teachings of the prior art to produce the claimed

invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347,

21 USPQ2d 1941 (Fed. Cir. 1992).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or

modified and that there must be some reason why one skilled in the art would be motivated to

make the proposed modifications. And although the motivation or suggestion to make

modifications must be articulated, it is respectfully submitted that there is no requirement that the

motivation to make modifications must be expressly articulated within the references themselves.

References are evaluated by what they suggest to one versed in the art, rather than by their

specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the

numerous court decisions supporting the position given above. The issue of obviousness is not

determined by what the references expressly state but by what they would reasonably suggest to

one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160

USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5

USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257,

1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti* et al 192 USPQ 278

(CCPA) that:

      (i)   obvious does not require absolute predictability;

      (ii)   non-preferred embodiments of prior art must also be considered; and

      (iii)   the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed

to know something more about the art than only what is disclosed in the applied references. In *In*

re Bode, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of

persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169

USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken

collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to

combine the applied references is accompanied by <u>select portions of the respective reference(s)</u>

which specifically support that particular motivation. As such, it is NOT seen that the Examiner's

combination of references is unsupported by the applied prior art of record. Rather, it is

respectfully submitted that explanation based on the logic and scientific reasoning of one

ordinarily skilled in the art at the time of the invention that support a holding of obviousness has

been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte*

Levengood 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence has been presented of corresponding claim elements in the prior art as discussed above, and Examiner has expressly articulated the combinations and the motivations for combinations as well as the scientific and logical reasoning of one skilled in the art at the time of the invention that fairly suggest Applicant's claimed invention as discussed in paper number 6 and above, incorporated herein.

At page 15-20 of the 13 October 2005 response, Applicant argues that the features in the Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references, including the newly added features in the 13 October 2005 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Huffman, Kuwamoto, Provost, Ertel, Winans, and McGauley, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action, and incorporated herein. In particular, Examiner notes that the recited features of "automatically generates a r13 October 2005equest to display a message" are taught by the combination of applied references. Examiner interprets Huffman's teachings of "the system automatically... [...] ...create[s] correspondence ... [...] ... generate[s] copies of letters to carbon copy or blind copy individuals with a unique message to each recipient... [...] ... utilizing standard form letters contained within the system," (Huffman; column 7, lines 7-20) as teaching this limitation. As per Applicant's argument that the applied references do not teach "processing a bodily injury claim", Examiner notes that it was the Provost reference, and not the Huffman reference, that was

applied to teach "automatically estimating a bodily injury general damages value of the

insurance claim" (Provost; column 6, lines 22-26, column 9, lines 35-42).

In response to Applicant's argument in the first paragraph on page 16 of the 13 October

2005 response that "none of the other references have been cited as teaching or suggesting"

"automatically generates a request to display a message to the user based on the displayed

processing steps" the Examiner respectfully disagrees and submits that Huffman's teachings as

detailed above, as well the combination of applied references, i.e. , Huffman, Kuwamoto,

Provost, Ertel, Winans, and McGauley, as discussed above, and the knowledge generally

available to one of ordinary skill in the art suggests or implies an insurance claims processing

system comprising the recited limitations.

In response to Applicant's arguments regarding the Abbruzzese reference at pages 16-18

of the 13 October 2005 response, these arguments are moot in view of the new grounds of

rejection.

In response to Applicant's argument at paragraph 2 on page 18 that the reasons why the

references "are combinable" has not been stated, Examiner notes that this has been discussed

above in the present Office Action. Moreover, the issue at hand is not whether the applied

references specifically teach each and every feature recited by Applicant, per se, but rather,

whether or not the prior art, when taken in combination with the knowledge of average skill in

the art would put the artisan in possession of the features as claimed. With regard to this issue,

the courts have held that even if a patent does not specifically disclose a particular element, said

element being within the knowledge of a skilled artisan, the patent taken in combination with

that knowledge, would put the artisan in possession of the claimed invention. *In re Graves,* 36

USPQ 2d 1697 (Fed. Cir. 1995).

In response to Applicant's argument at paragraph 4 on page 18 that the Examiner's

conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized

that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight

reasoning. But so long as it takes into account only knowledge which was within the level of

ordinary skill at the time the claimed invention was made, and does not include knowledge

gleaned only from the Applicant's disclosure, such a reconstruction is proper. See In re

McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to Applicant's

disclosure. The cited but not applied references Freedman, et al., U. S. Patent Application

Publication Number 2002/0002475, DiRienzo, U. S. Patent Number 6, 003, 007, Gamble, et al., ,

U. S. Patent Number 6, 163, 770, Sarin, et al., U. S. Patent Number 6, 003, 011, Campbell, U. S.

Patent Application Publication Number 2001/0041993, and Wamsley et al., U. S. Patent Number

5, 956, 687 teach the environment of electronically processing insurance claims.

13.   Any response to this action should be mailed to:

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14.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The

examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The
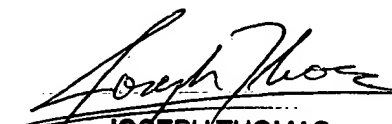
examiner can also be reached on alternate Fridays.

15.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or

relating to the status of this application or proceeding should be directed to the Receptionist

whose telephone number is (571) 272-3600.

16.   Information regarding the status of an application may be obtained from the Patent

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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Natalie A. Pass

December 12, 2005

                                                    JOSEPH THOMAS
                                            SUPERVISORY PATENT EXAMINER